

Transfer of Patents and Obligations

Dr. Claudia Tapia, LLM

Director, IP Policy,

Patent & Standards Strategy

ctapiagarcia@rim.com

All views expressed are those of the author and do not necessarily represent the views of the employer

EUROPE: CEN / CENELEC Guide 8

- ▶ CEN–CENELEC Guidelines for Implementation of the Common IPR Policy on Patent

Transfer (7.3)

„(...) In the event the patent holder of a declared essential patent transfers his patent ownership to a third party, he is requested to notify the transferee of any obligation resulting from such a declaration”.

EUROPE: ETSI

- ▶ **Annex 6: Intellectual Property Rights Policy, clause 6, Availability of Licences:**

“In the event a MEMBER assigns or transfers ownership of an ESSENTIAL IPR that it disclosed to ETSI, the MEMBER shall exercise reasonable efforts to notify the assignee or transferee of any undertaking it has made to ETSI pursuant to Clause 6 with regard to that ESSENTIAL IPR.”

- ▶ **Section 4.2 of the ETSI Guide:**

“(…) it is desirable that, to the maximum extent possible in each legal jurisdiction, when ownership of an ESSENTIAL IPR is transferred, any applicable licensing undertaking should automatically transfer to the new owner. (…)

Therefore, ETSI encourages:

- *Prospective assignees or transferees to check for applicable licensing declarations, for example, by searching for registrations of such declarations in the ETSI IPR database;*
- *MEMBERS that have given General IPR licensing declarations to draw the attention of any assignee or transferee to the possibility that undertakings given in such declarations might apply to the IPRs that are to be assigned or transferred.”*

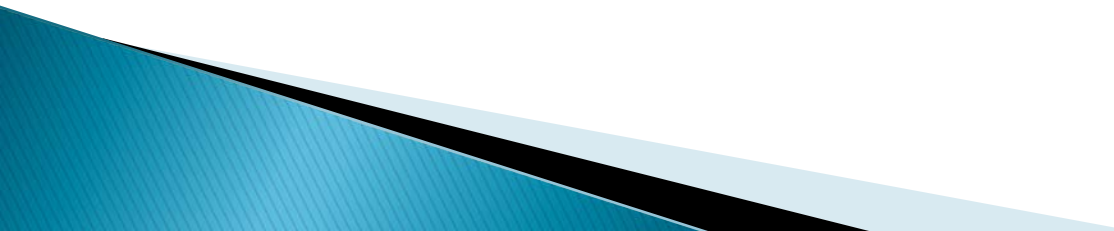
CHINA– IPR Policy of AVS (Audio Video Coding Standard WG)

Article 22: “Member agrees that it and its Affiliates have not and will not transfer Patents having Necessary Claims for the purpose of circumventing its licensing obligations under this IPR Policy. Any transfer by Member or its Affiliates to a third party of a Patent having Necessary Claims shall be subject to the Member's and its Affiliates' existing obligations, if any, under this IPR Policy. Member and its Affiliates may choose the manner in which it complies with this Article. The inclusion in any agreement for assigning a Necessary Claim(s), of a provision that such assignment is subject to existing licenses and obligations to license imposed on the Member and its Affiliates by standards bodies, specification development organizations, or similar organizations (or language of similar import or effect) shall be sufficient to comply with this Article.”

CHINA – CCSA IPR Policy

adopted by the Council of CCSA on September 13, 2007

Annex 2: Patent Licensing Declaration
(General): *“Furthermore, by making this licensing declaration, I guarantee that any transferee of a patent/patent application contained herein, if applicable, shall be subject to the existing obligation under this licensing declaration”.*

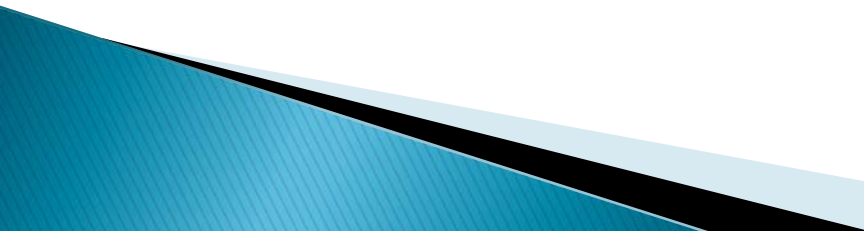


Proposal

"In the event a MEMBER assigns or transfers ownership of an ESSENTIAL IPR, which is subject to a licensing undertaking provided in accordance with Clause 6.1 of the ETSI IPR Policy, the MEMBER shall have the assignee or transferee agree to be bound by the undertaking it has made with regard to that ESSENTIAL IPR. ~~that it disclosed to ETSI, the MEMBER shall exercise reasonable efforts to notify the assignee or transferee of any undertaking it has made to ETSI pursuant to Clause 6 with regard to that ESSENTIAL IPR.~~ By complying with the above, the MEMBER has discharged in full all of its obligations and liability with regards to the licensing undertakings after the transfer or assignment. The above paragraph is not intended to place any duty on the MEMBER to compel compliance with Clause 6.1 of the ETSI IPR Policy by the assignee or transferee after the assignment or transfer occurs."

Case No COMP/M.6381 – Google/Motorola Mobility, 13 Febr 2012

Para . 59.” (...) non-SEPs could also potentially be the basis for foreclosure of rivals and possible abusive conduct. For example, in exceptional circumstances, notably where a technology has become an indispensable input for competitors, a refusal to grant access to that technology may be abusive.”



Thank you for listening!